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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,122	02/15/2002	Herbert Peiffer	01/026 MFE	2899

7590 11/12/2003

ProPat, L.L.C.
2912 Crosby Road
Charlotte, NC 28211-2815

EXAMINER

CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 11/12/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

CLO12

Advisory Action

Application No.

10/077,122

Applicant(s)

PEIFFER ET AL.

Examiner

Vivian Chen

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.**

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see DETAILED ADVISORY ACTION.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see DETAILED ADVISORY ACTION.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-13.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: Detailed Advisory Action

Vivian Chen
Primary Examiner
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DETAILED ADVISORY ACTION

Response to Proposed Amendments

1. The proposed amendments will **NOT** be entered because they raise new issues that would require further consideration and/or search. The proposed new claim limitation in claim 14 regarding the exclusion of particles from layer B was not previously claimed.

Terminal Disclaimer

2. In the After-Final filed 10/1/2003, Applicant indicates that a Terminal Disclaimer for copending Application No. 10/077,454 has been submitted. However, no Terminal Disclaimer is present in Applicant's response.

The obviousness-type double patenting rejection based on copending Application No. 10/077,454 remains outstanding.

Response to Arguments

3. Applicant's arguments filed 10/1/2003 have been fully considered but they are not persuasive.

(A) Applicant argues that PEIFFER ET AL '181 fails to disclose the recited particle system in its entirety. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). PEIFFER ET AL

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'181 is relied upon to illustrate that it is well known in the art to produce multilayer polyester packaging films with antiblocking particles of the general size recited by Applicant.

(B) Applicant argues that there is no motivation to combine PEIFFER ET AL '181 with the teachings of HASEGAWA ET AL or KATOH ET AL because PEIFFER ET AL '181 uses adjustments in polymeric layer composition to address slip and optical issues. However, as admitted by Applicant, the reference clearly envisions and suggests the additional use of known antiblocking particles to further enhance or optimize the film handling properties of the film. Applicant has not provided any probative evidence of criticality or unexpected results which is commensurate in scope with the present claims, especially in regard to particle sizes and SPAN values.

(C) Applicant further argues that there is no motivation to motivation to use the particle system as disclosed in KATOH ET AL because the reference is directed to monolayer films for magnetic tapes and the reduction of dropouts. However, KATOH ET AL clearly states that the disclosed films are also suitable for packaging applications (lines 37-40, col. 10). Although KATOH ET AL does not explicitly disclose the use of such particles in multilayer films, one of ordinary skill in the art would reasonably believe that the benefits of using a particle system having a narrow particle size distribution (e.g., uniformity of protrusions and the resultant increased uniformity and controllability of film running and abrasion resistance) as disclosed in KATOH ET AL would apply to multilayer films using such particles. Also, one of ordinary skill in the art would reasonably believe that a reduction in film dropouts would be beneficial to a packaging film in order to ensure good film handling throughout the manufacturing process as well as minimizing the presence of surface defects that may adversely affect subsequent coatings

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(e.g., metallization or deposition of ceramic thin layers, etc.). Applicant has not provided any probative evidence to the contrary.

(D) Applicant further argues that KATOH ET AL teaches away from the claimed invention because the reference uses a specific type of spherical silica particle. However, since the present claims do not specify the shape or composition of the particle used, they do not preclude the use of spherical silica particles as used in KATOH ET AL.

(E) Applicant further argues that KATOH ET AL teaches away from the claimed invention because KATOH ET AL suggests the use of two sizes of particles. However, it is clear from the reference that the second particle size/type is optional and not an essential component of the prior art film (e.g., see claim 1 of KATOH ET AL). Furthermore, since the proposed amendment has not been entered, the claims *as presently amended* do not preclude the presence of additional particles. Applicant has not provided probative evidence of criticality or unexpected results commensurate in scope with the present claims.

(F) Applicant argues that HASEGAWA ET AL teaches away from the claimed invention because the reference uses a specific type of spherical silica particle. However, since the present claims do not specify the shape or composition of the particle used, they do not preclude the use of spherical silica particles as used in HASEGAWA ET AL.

(G) Applicant further argues that HASEGAWA teaches away from the claimed invention because the reference requires the use of two sizes of particles. However, since the proposed amendment has not been entered, the claims *as presently amended* do not preclude the presence of additional particles. Applicant has not provided probative evidence of criticality or unexpected results commensurate in scope with the present claims.

(H) Applicant further argues that there is no motivation to motivation to use the particle system as disclosed in HASEGAWA ET AL because the reference is directed to monolayer films. Although the references does not explicitly disclose the use of such particles in multilayer polyester films, the reference clearly indicates that the disclosed particle containing layers is intended for use in multilayer films in general, therefore, one of ordinary skill in the art would reasonably believe that the benefits of using a particle system having a narrow particle size distribution (e.g., uniformity of protrusions and the resultant increased uniformity and controllability of film running and abrasion resistance) as disclosed in HASEGAWA ET AL would apply to multilayer films incorporating additional polyester film layers. Applicant has not provided any probative evidence to the contrary.

(I) Applicant argues that the claimed particle sizes and size distribution are critical and provide unexpected results with regard to optical and film handling properties. However, while the specification provides some indication of superior performance, the showing in the specification is not commensurate in scope with the claimed invention (e.g., in regard to the ranges of particle sizes, particle size distribution, type of particle, etc.) in view of the general teachings in KATOH ET AL and HASEGAWA ET AL with regard to the known benefits of using particles with a narrow particle size distribution.

(J) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., 'conventional' silica particles) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

November 10, 2003


Vivian Chen
Primary Examiner
Art Unit 1773